

REMARKS

Applicant has added new method claims 12-14 to track pending system claims 4, 5 and 11, respectively, in order to round out the scope of protection of the claims in this application and has amended claim 8 to correct an inadvertent error in terminology introduced in the Supplemental Preliminary Amendment filed August 12, 2004. The amendments do not introduce new matter and should be entered.

Claims 7 and 8 stand rejected as anticipated by Berry. The Examiner claims that Berry anticipates these claims in part because “[t]he approximate hinge and prostheses dimensions, e.g., hinge radius of an affected part, are determined by tomography and the prostheses are accordingly sized and implanted to accommodate individual anatomy (col. 4, lines 19-23).” This rejection and its supporting reasoning are respectfully traversed.

Independent claim 7 is a method claim that calls for the steps of “determining the hinge radius of an affected joint” and “selecting a prosthesis with a hinge radius approximating the hinge radius of the affected joint.” Berry discloses the performance of neither of these steps. The portion of Berry cited by the Examiner says not a word about the hinge radius of the vertebrae in question, but instead refers in very general terms to “the exact size of the implant 11.” The drawings in Berry do not show hinge radii, nor is there a word in Berry about either measuring hinge radii or of matching the prostheses chosen to the hinge radii of the vertebrae in question. Although applicant’s invention is elegantly simple, Berry says nothing that puts it in possession of a person of ordinary skill in the art, who would see nothing in Berry that instructs him or her to carry out the claimed steps of measuring a hinge radius and selecting a prosthesis to fit the measured hinge radius. The specification of Berry fails to disclose in any way that the radii of curvature of the hinge surfaces 29, 43 have any correlation to the hinge radii of the involved vertebrae. In fact, the radii of curvature of the surfaces 29, 43 shown in Berry’s figures seem to be quite a bit smaller than the hinge radii of the involved vertebrae. For these reasons, Berry does not identically disclose the method of the invention as claimed in claim 7.

System claim 8 specifically requires a set of prostheses in which the prostheses closer to the head of the subject into which they are to be implanted (“in a cranial direction” in the words of claim 8) have hinge radii that are greater than the hinge radii of the prostheses that are relatively toward the base of the spine (“in a direction more caudal” in the words of claim 8). Berry discloses the opposite of what applicant claims, as can be seen from Berry’s Fig. 12 and the supporting disclosure. Fig. 12 unmistakably shows the radii of curvature of the hinge surfaces increasing as one proceeds down the spine in the caudal direction. This increase in radii, contrary to the claimed invention, is also illustrated at col. 8, line 18 – col. 9, line 8, of Berry: In the C1-C3 section R2, the hinge radius of curvature, is 0.188 inches, in the C4-C7 section R2 is 0.219 inches and in the L1-L5 section, R2 is 0.4375 inches. As a result, Berry not only fails to disclose the invention of claim 8, it implicitly teaches away from it.

Claims 4, 5 and 11 stand rejected under 35 USC 103(a) on Berry alone. The Examiner asserts that it would have been obvious to choose the claimed dimensions “since it has been held that where the general conditions of a claim are disclosed in the prior art, i.e., sliding joint prostheses of different sizes, discovering the optimum or workable ranges of the same involves only routine skill in the art.” This rejection and its supporting reasoning are respectfully traversed.

This rejection suffers from two crucial defects.

First, it relies on the disclosures in Berry that allegedly support the anticipation rejection of base claim 8, which applicant has already shown Berry does not provide. For that reason alone, the rejection is untenable.

Second, it assumes what the “general conditions” of the claims are, contrary to the requirement that the subject matter of the claimed invention as a whole must be evaluated for obviousness over the prior art. In this case, one of the key features of the invention which Berry does not even hint at is the need to measure the hinge radii of the affected vertebrae so that the surgeon may choose appropriate hinge radii for the prostheses of the claimed system. There is

nothing in Berry which suggests in any way that the hinge radii of the vertebrae are related to the selection of the prostheses or, based on such a selection, that the hinge radii should relate to the location along the spine as claimed.

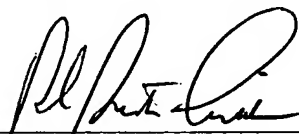
Early action allowing claims 4, 5, 7, 8 and 11-14 in this application is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **246472006000**.

Respectfully submitted,

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